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I hereby certify that this correspondence is being deposited with the United States Postal Services on the date set forth below as First Class Mail in an envelope addressed to: Commissioner for Patents, Washington, D.C. 20231.  
Date of Signature September 25, 2000  
and Deposit: [Signature]  
Attorney of Record



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Henry Goldstein, et al.  
Serial No.: 09/368,437  
Filed: August 4, 1999  
For: POST-FERMENTATION KETTLE HOP ESSENCES  
AND FLAVORANTS AND METHODS OF MAKING  
AND USING THEM  
Group Art Unit: 1761  
Examiner: C. Snerrer

Commissioner for Patents  
Washington, D.C. 20231

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RESPONSE TO RESTRICTION REQUIREMENT

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Dear Sir:

In response to the restriction requirement mailed September 1, 2000, Applicants make the following remarks.

REMARKS

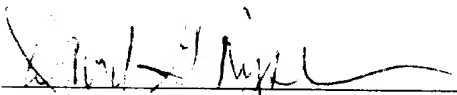
The summary page of the September 1, 2000 Office Action stated that claims 21 - 43 are pending in the application. This is incorrect. Claims 25 - 43 and 68 - 74 are pending in the application (see Applicants' August 4, 1999 Preliminary Amendment). As a result of this oversight, the Office Action did not address the status of claims 68 - 74 vis a vis the restriction requirement. Accordingly, it is respectfully requested that the Examiner reissue the September 1, 2000 Office Action so that the status of claims 68 - 74 can be addressed.

In connection with reissuing the Office Action, the Applicants respectfully request that the Examiner reconsider the restriction requirement. In this regard, the Examiner's attention is directed to Exhibit A which is a copy of the restriction requirement from the parent application (U.S. Serial No. 08/838,217). Applicants respectfully submit that in view of the restriction requirement in the parent case, claims 25 - 43 and 68 - 74 of the present application should be restricted to no more than four groups (see Groups II - V in the parent case restriction). Moreover, contrary to the statement at page 4 of the September 1, 2000 Office Action, the search for Groups I and VII is identical to the search required for Groups II and VIII (class 426, subclasses 534 and 600). Therefore, there is no unnecessary burden on the Office to retain Groups I and II together and Groups VII and VIII together.

No fee is considered necessary to enter the above response. However, if any fees are deemed necessary, please charge Deposit Account 17-0055 accordingly.

Respectfully submitted,  
Henry Goldstein, et al.

September 25, 2000

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## DETAILED ACTION

### *Election/Restriction*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1 to 24 and 44 to 67, drawn to methods for making a purified kettle hop essence and flavorant, classified in class 426, subclass 600.
  - II. Claims 25 to 31 and 68 to 74, drawn to a kettle hop essence and flavorant, classified in class 426, subclass 600.
  - III. Claims 32 to 36, drawn to a method making hop flavored beverages, classified in class 426, subclass 16.
  - IV. Claims 37 to 39, drawn to hop flavored beverages, classified in class 426, subclass 592.
  - V. Claims 40 to 43, drawn to a kettle hop essence and flavorant, classified in class 426, subclass 600.
2. The inventions are distinct, each from the other because of the following reasons:
3. Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process, i.e., synthetically.
4. Inventions III and IV are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be

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used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process, i.e. by using synthetic flavorants and essences.

5. Inventions II and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process of using that product, i.e. to produce hop flavored solid foods or as a medicant.

6. Inventions II and V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together, or they have different modes of operation, or they have different functions, or they have different effects. (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different effects upon the flavors produced in a beverage or food.

7. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

8. Because these inventions are distinct for the reasons given above and the search required for Groups I, II and V is not required for Groups III and IV, restriction for examination purposes as indicated is proper.

9. This application contains claims directed to the following patentably distinct species of the claimed invention:

a. The claims are directed, with respect to the conversion of glycosides, to (1)enzymatic conversion of glycosides; (2)fermentative conversion of glycosides; or (3)acid hydrolysis conversion of glycosides.

b. The claims are also directed to two methods of purifying the extract; either by (1)liquid chromatography purification; or (2)membrane purification.

c. The claims are also directed to adding the extract to a beverage either (1)before fermentation; or (2)after fermentation.

Depending on which claims are elected from the restricted groups, Applicants need to elect one species from a., b., and/or c.

10. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, with respect to species a., Claims 1 and 44 are generic; with respect to species b., Claims 1 and 44 are generic; and with respect to species c., Claim 32 is generic.

11. Applicant is advised that a response to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

12. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations

of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

13. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

14. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

15. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Curtis Sherrer whose telephone number is (703) 308-3847. The examiner can normally be reached on Monday through Friday from 6:00 to 2:30.

17. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Lacey, can be reached on (703)-308-3535. The fax phone number for this Group is (703)-305-3602.

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18. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0651.

A handwritten signature in black ink, appearing to read "Curtis E. Sherrer". The signature is fluid and cursive, with a long horizontal stroke extending to the right.

Curtis E. Sherrer

October 8, 1997